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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,623	10/18/2004	Takashi Namioka	890050.504USPC	4077
500 7590 04/20/2006 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			EXAMINER JONES, CRYSTAL L	
			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/511,623		NAMIOKA ET AL.	
	Examiner		Art Unit	
	Crystal Jones		2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 6 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of **50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The aforementioned claims recite, "a first kind of optical recording medium comprising at least a substrate, a conductive layer

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formed on the substrate and a light transmission layer formed on the conductive layer and **containing a first material** and a second kind of optical recording medium comprising at least a substrate, a conductive layer formed on the substrate and a light transmission layer formed on the conductive layer and **containing a second material** different from the first material". The feature containing the first and second materials is unclear as to whether the feature is the "medium", "substrate", "conductive layer", or "light transmission layer".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka (JP 10-143986) in view of Yanagisawa et al. (U.S. Patent 5,389,475).

Regarding claims 1 and 4, Yoshioka discloses a(n) apparatus (Fig. 3)/method (Fig. 4) for discriminating an optical recording medium comprising at least a substrate (Fig. 3, element 25), the apparatus for discriminating an optical recording medium comprising a first electrode (Fig. 3, element 23) and a second electrode (Fig. 3, element 24), a means for applying a signal to the first electrode (Fig. 3, element 26), and a means for detecting a signal appearing at the second electrode (Fig. 3, element 29).

Yoshioka fails to disclose a conductive layer formed on the substrate and a light transmission layer formed on the conductive layer with electrodes disposed in the

vicinity of a surface of the light transmission layer disposed on a side opposite from the substrate side.

Yanagisawa et al. disclose a conductive layer (Fig. 6, element 602) formed on the substrate (Fig. 6, element 601) and a light transmission layer (Fig. 6, element 604) formed on the conductive layer, electrodes which can be disposed in the vicinity of a surface of the light transmission layer disposed on a side opposite from the substrate side (Fig. 1, element 201).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus/method of Yoshioka with a recording medium and relative positioning of the electrode(s) as disclosed by Yanagisawa et al.

Motivation for the above combination is to promote higher density recording with utilization of a probe electrode (Yanagisawa et al. (Col. 3, lines 43-52).

Regarding claims 2 and 5, Yoshioka discloses a(n) apparatus (Fig. 3)/method (Fig. 4) for discriminating an optical recording medium constituted so as to be able to discriminate between a first kind of optical recording medium ([0037]--CD) comprising at least a substrate (Fig. 3, element 25) and containing a first material and a second kind of optical recording medium ([0037]--DVD) comprising at least a substrate and containing a second material different from the first material (DVDs contain different materials than CDs), the apparatus for discriminating optical recording media comprising a first electrode (Fig. 3, element 23) and a second electrode (Fig. 3, element 24) which can be disposed in the vicinity of a surface of the light transmission layer disposed on a side opposite from the substrate side, a means for applying a signal to the

first electrode (Fig. 3, element 26), and a means for detecting a signal appearing at the second electrode (Fig. 3, element 29).

Yoshioka fails to disclose conductive layers formed on the substrates and light transmission layers formed on the conductive layers with electrodes disposed in the vicinity of a surface of the light transmission layer disposed on a side opposite from the substrate side.

Yanagisawa et al. disclose a conductive layer (Fig. 6, element 602) formed on the substrate (Fig. 6, element 601) and a light transmission layer (Fig. 6, element 604) formed on the conductive layer, electrodes which can be disposed in the vicinity of a surface of the light transmission layer disposed on a side opposite from the substrate side (Fig. 1, element 201).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus/method of Yoshioka with a recording medium and relative positioning of the electrode(s) as disclosed by Yanagisawa et al.

Motivation for the above combination is to promote higher density recording with utilization of a probe electrode (Yanagisawa et al. (Col. 3, lines 43-52).

Allowable Subject Matter

4. Claims 3 and 6 are allowed.

Regarding claims 3 and 6, no reference alone or in combination discloses a(n) apparatus/method for discriminating an optical recording medium comprising a light transmission layer formed on a recording layer constituted so as to be able to discriminate the number of the recording layers included in an optical recording medium.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tsuchiya et al. (U.S. Patent 5,787,061).

Tsuchiya et al. disclose a disc discriminating apparatus that determines disc type based on the thickness of the substrate of the optical disc but fails to disclose the use of electrodes to determine disc type.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal Jones whose telephone number is 571-272-2849. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 6 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WAYNE YOUNG
SUPERVISORY PATENT EXAMINER